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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/353,407 07/15/99 LUBENOW H QGN-004.0-US

HM22/0104

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EXAMINER

CHAKRABARTI, A

ART UNIT

PAPER NUMBER

1655

DATE MAILED:

01/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.
09/353,407

Applicant(s)
Lubenow et al.

Examiner
Arun Chakrabarti

Group Art Unit
1655



THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☒ expires 3 months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☒ Appellant's Brief is due two months from the date of the Notice of Appeal filed on Dec 20, 2000 (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Dec 20, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):

☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

☒ will not be entered because:

- ☐ they raise new issues that would require further consideration and/or search. (See note below).
- ☐ they raise the issue of new matter. (See note below).
- ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: See attached sheet.

- ☐ Applicant's response has overcome the following rejection(s):

- ☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☐ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: _____

Claims objected to: _____

Claims rejected: 1-66

- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Other

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DETAILED ACTION

The proposed amendment will not be entered because they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. Even if the amendments were entered, the peptide, polypeptide, or protein molecules purification of the claimed invention would have been obvious and could have been rejected under 35 U.S.C. 103 (a) only over McCoy et al. (U.S. Patent 5,646,016) (July 8, 1997) reference itself or McCoy et al. (U.S. Patent 5,646,016) (July 8, 1997) in view of Zhang et al. (U.S. Patent 5,942,391) (August 24, 1999). Applicant argues that neither McCoy nor Zhang reference teaches the peptide, polypeptide, or protein molecules purification of the claimed invention. Applicant argues that the word "protein detection or purification" was not found in Zhang or McCoy references and only the word "nucleic acids isolation" are found. Applicant argues that because Zhang or McCoy has a preferred embodiment of nucleic acids, these references are limited to the preferred embodiment. This argument is not persuasive. As MPEP 2123 states, "Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 169 USPQ 423 (CCPA 1971)." MPEP 2123 also states "A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories, 10 USPQ2d 1843 (Fed. Cir. 1989)." It is clear that simply because Zhang or McCoy references have a preferred embodiment, this embodiment does not prevent the reference from suggesting broader embodiments in the disclosure and that this does not constitute a

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teaching away. Although McCoy reference uses fusion proteins purification, the property of purifying any proteins or polypeptides is inherently present in this chemically and structurally identical molecule. For example, McCoy teaches that such affinity particle columns can be used to purify any proteins by the conventional procedures of binding and eluting from the matrix (See Column 3, lines 23-31 and Column 4, lines 45-57) . Moreover, MPEP 2111 states, "Claims must be given their broadest reasonable interpretation. During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification".

Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than it is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)". In this case, any affinity particles under any suitable conditions can be used for isolating a peptide, polypeptide or protein.


W. Gary Jones
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1/2/01